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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,774	08/31/2001	Anthony Robert Thomas	82001-0194	9205
24633	7590	09/27/2004	EXAMINER	
HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004			SNAPP, SANDRA S	
		ART UNIT	PAPER NUMBER	
			3624	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/942,774	THOMAS ET AL.
Examiner	Art Unit	
Sandra Snapp	3624	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 June 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 17,32 and 33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16,18-31 and 34-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office Action is in response to the Amendment filed 6-17-04. Currently, claims 1-16, 18-31 and 34-41 are pending in the application. Claims 17, 32 and 33 have been cancelled from the application. New claim 41 has been added with the amendment of 6-17-04.

### *Claim Objections*

Claims 23, 28 and 35 are objected to because of the following informalities:

In claims 23 and 35, in the preamble it states, “a *computer computer* readable medium,”

and

In claim 28, the last phrase reads, “sellers auction” however the term “sellers” should be “seller’s.” Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because the phrase “if no winning bids” is a conditional statement, however the claim does not state what will happen if winning bids are received. It is presumed the non-public auction will stay as such, however such is just a presumption without further clarification.

***Claim Rejections - 35 USC § 101***

The rejection of claims 1-16, 23-31 and 34-40 under 35 U.S.C. 101 is herein withdrawn in view of the amendment filed 6-17-04.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-41 are rejected under 35 U.S.C. 102(b) as being anticipated by the Silverman patent (US 5,924,082).

The Silverman patent discloses a computer program product comprising a computer readable medium having computer readable code embodied therein for conducting a multiple level non-public auction in a transportation services market among a plurality of buyers and a plurality of sellers, the code providing instructions to perform operations comprising:

Establishing a format of the auction as having multiple levels of non-public auction, the levels being arranged from a first level to a last level (col. 4, line 28 through col. 5, line 15),

Defining auction parameters detailing a form of acceptable bids and an identification of a transportation service or capacity being auctioned, the auction parameters including the designation of certain buyers or sellers as preferred trading partners for one or more levels of the multiple level non-public auction wherein only those buyers and sellers designated as preferred

trading partners may bid in any one level of the multiple level non-public auction, starting at the first level and then for each level of the multiple level non-public auction (col. 4, line 28 through col. 5, line 15),

Publishing notice to the buyers or the sellers designated as preferred trading partners (col. 4, lines 50-67),

Receiving bids from the designated preferred trading partners and monitoring the received bids for a winning bid (col. 4, lines 50-67), and

Proceeding to a next level of the non-public auction, if available, if an instruction is received indicating no winning bidder has been identified from the received and monitored bids (col. 7, line 35 through col. 8, line 65) (claim 35);

Wherein the instruction indicating no winning bidder has been identified from the received and monitored bids comprises a manual instruction by an auction initiator (col. 7, line 25 through col. 8, line 65) (claim 36);

The instruction indicating no winning bidder has been identified from the received and monitored bids is automatically given after the expiration of a set period of time of receiving and monitoring bids for a current level within which said set period of time said winning bid was not identified (col. 7, line 25 through col. 8, line 65) (claim 37);

The winning bid must meet a pre-determined strike price, and wherein a received bid meeting the strike-price comprises an instruction to terminate the auction without proceeding to any remaining levels (col. 12, lines 18-36) (claim 38);

The last level comprises an auction opened to all of the plurality of buyers and the plurality of sellers (col. 4, lines 28-67, all are capable if all meet the ranking criteria) (claim 39);

Wherein preferred trading partners are designated for each level such that a number of potential bidders are added as preferred trading partners for the auction as each next level begins (col. 4, lines 28-67) (claim 40); and

If the winning bid is identified from the received and monitored bids, the code further providing instructions to terminate the auction and send a tender offer regarding the winning bid (col. 8, lines 1-67) (claim 41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 18-31 and 34, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the Brown patent (US 5,794,219) in view of the Barni et al. patent (US 6,064,981).

The Silverman patent, as modified by the Barni patent, discloses an electronic market for negotiating transactions regarding the exchange of transportation services between buyers and sellers, said electronic market comprising:

An auction transaction system, said auction transaction system being adapted to enable any one of said buyers and said sellers to conduct auctions for the exchange of transportation services (col. 4, lines 4-27);

A catalog transaction system in electronic communication with the auction transaction system, said catalog transaction system being adapted to enable said sellers to post quoted rates for various transportation services such said buyers may review quoted rates associated with desired transportation services (col. 10, line 59 through col. 11, line 5); and

A means for the buyer and sellers to communicate with the auction transaction system and the catalog transaction system, said means for communicating comprising an electronic data interchange system in electronic communication with the auction transaction system and the catalog transaction system and adapted to enable said buyers and said sellers to interact through the catalog transaction system and the auction transaction system, and the buyers and the sellers being capable of designating selected other buyers and sellers as preferred trading partners with the auction transaction system or the catalog transaction system, wherein particular ones of the quoted rates and particular ones of the auctions can be optionally made available to only said preferred trading partners (col. 9, line 25 through col. 10, line 55 – the Silverman patent is not directed to transportation services, however in col. 13, lines 31-57 it discloses that it is capable of accommodating various types of goods/services, as such the Barni patent is cited herein because it teaches a negotiation system directed to the transportation of goods – Barnie, Abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system with the teachings of the Barni system so as to provide a more complete negotiation system that would accommodate various types of goods as well as for the delivery of such negotiated goods. (claim 1);

An execution system in communication with said auction transaction system and said catalog transaction system, said execution system allowing buyers and sellers to execute

shipping transactions negotiated by said auction transaction system and said catalog transaction system (Silverman, col. 12, lines 1-17 and col. 13, lines 30-58, Barni teaches transportation of goods, Abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system with the teachings of the Barni system so as to provide a more complete negotiation system that would accommodate various types of goods as well as for the delivery of such negotiated goods. (claim 2);

The catalog system allows an inquiring buyer to identify appropriate shipping services from the posted quoted rates for a desired shipment and said execution system sends electronic purchase orders to sellers associated with the select ones of the appropriate shipping services at the election of the inquiring buyer (Silverman, col. 7, lines 50-55 and Barni teaches shipping services, Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system with the teachings of the Barni system so as to provide a more complete negotiation system that would accommodate various types of goods as well as for the delivery of such negotiated goods. (claim 3);

The auction shipping system allows an auction initiating party to identify winning bids for transportation services being auctioned and the execution system automatically sends electronic tender offers to the auction initiating party detailing the winning bids and associated bidders (Silverman, col. 7, line 35 through col. 8, line 65) (claim 4);

The auction initiating party can electronically accept or decline the electronic tender offers (Silverman, col. 7, line 50 through col. 8, line 10) (claim 5);

The execution system receives status update messages regarding scheduled and in transit shipments and the communication means enables the buyer and seller to review the status update

messages (Silverman, updating in col. 10, lines 33-40), and Barni teaches updating transportation schedules, (col. 6, lines 45-47, col. 7, lines 28-30 and Fig. 3) Silverman discloses an updating mechanism, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system to include the teachings of the Barni system, so as to provide for accurate, updated, current information to the users (claim 6);

In response to receiving certain status update messages the execution system initiates commands to a remote private network of a selected buyer and seller (Silverman, col. 10, lines 55-58) (claim 7);

The command is utilized by the private network to trigger accounting transactions regarding the scheduled and in transit shipments (Silverman, col. 12, lines 14-47) (claim 8);

The command comprises email messages directed to individuals associated with the selected buyer or seller and the email reports relevant status information to the individuals based upon roles assigned to each of the individuals (Silverman, col. 11, line 50 through col. 12, lines 5) (claim 9);

The auction transaction system further enables buyers and sellers designated as preferred trading partners to bid in non-public and public auctions while those buyers not designated as preferred trading partners can bid only in public auctions (Silverman, col. 4, lines 4-27, if so desired a user can put in such parameter that would allow for anyone to participate, thus essentially having a public auction, also, since the parameters can be changed, it is possible for the auction to go from public-to-private and private-to-public) (claim 10);

The auction transaction system further enables an auction initiating party to hold an auction that comprises a plurality of levels wherein a first level begins the auction as a non-

public auction and a final level completes the auction as a public auction (Silverman, col. 4, lines 4-27) (claim 11);

The auction transaction system further enables an auction initiating party to hold a non-public auction that comprises a plurality of levels wherein the designated preferred trading partners differ for each level of the non-public auction (Silverman, col. 4, lines 4-27) (claims 12 and 26);

The auction initiating party has the option of transforming the non-public auction into a public auction if no winning bid is submitted by the designated preferred trading partners (Silverman, col. 4, lines 4-27) (claim 13);

The means for communicating comprises a web platform system in electronic communication with the auction transaction system and the catalog transaction system (Silverman shows a network in the Abstract) and Barni teaches an interactive web platform (Barni, col. 1, lines 23-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system with the teachings of the Barni system so as to reach a broader user base and make it more user friendly (claim 14);

The web platform system is adapted to provide an interactive web site for use by the buyers and the sellers, said interactive web site being securely accessible over the Internet (Silverman shows a network in the Abstract) and Barni teaches an interactive web platform (Barni, col. 1, lines 23-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Silverman system with the teachings of the Barni system so as to reach a broader user base and make it more user friendly (claim 15);

The interactive web site provides tracking and tracing information to each buyer of shipments that are scheduled to be delivered or in the process of being delivered by the sellers (Silverman, col. 13, lines 11-14) (claim 16);

The electronic data interchange system is adapted to enable electronic communication with private computer networks of the buyer and sellers (Silverman, col. 7, lines 25-30) (claim 18);

The electronic data interchange system uploads quoted rates for various transportation services from a private computer network of at least one seller (Silverman, col. 7, lines 25-30) (claim 19);

The electronic data interchange system downloads quoted rates to a private computer network of at least one buyer (Silverman, col. 7, lines 25-30) (claim 20);

An execution system in electronic communication with the auction transaction system and the catalog transaction system and wherein the electronic data interchange system sends tender offers and purchase orders generated by the execution system electronically to the sellers via the electronic data interchange system (Silverman, col. 7, line 35 through col. 8, line 65) (claim 21); and

The execution system interacts with billing systems and messaging systems of private networks of the buyers and the sellers through the electronic data interchange system (Silverman, col. 3, line 65 through col. 4, line 3) (claim 22).

The Silverman patent, as modified by the Barni patent, discloses a computer program product comprising a computer readable medium having computer readable code embodied

therein for negotiating transactions regarding the exchange of transportation services between buyers and sellers that comprise a market place, said code providing instructions to perform operations comprising:

Establishing an electronic exchange network, said exchange network enabling the buyers at their option to schedule desired services according to transaction catalogs published by the sellers, to place bids on transportation capacity being auctioned by sellers in seller's auctions, or to conduct a buyer's auction enabling sellers to place bids on rights to perform the desired services of the buyers (Silverman, col. 10, line 59 through col. 11, line 62), and

Having at least some of the buyers or some of the sellers designate selected other buyers, other sellers, or combinations thereof as preferred trading partners with regard to one or more of the transaction catalogs, the auctioned capacity, and the auctioned rights to perform services, and wherein the preferred trading partners for each of the some buyers or some sellers are given preferential access over buyers or sellers not designated as preferred trading partners in the electronic exchange network to certain discounted shipping rates or certain auctions (Silverman, col. 9, line 25 through col. 10, line 55) (claim 23);

The electronic exchange network enables auctions to be either non-public or public, wherein only buyers designated by an initiator of a non-public seller's auction as preferred trading partners can place bids on particular transportation capacity being auctioned in the non-public seller's auction, and wherein only sellers designated by an initiator of a non-public buyer's auction as preferred trading partners can place bids on the particular right to perform the desired services that is being in the non-public buyer's auction (Silverman, col. 5, lines 49-60) (claim 24);

The non-public auctions are converted into public auctions if no winning bids are received from the designated trading partners (Silverman, col. 4, line 28 through col. 5, line 15 - the system can convert to and from private to public depending upon the parameters that are entered, also since the parameters can be changed at any time, this would allow for the change from public to private and visa versa) (claim 25);

The non-public auctions contain multiple auction levels wherein different preferred trading partners are designated for each level (Silverman, col. 4, line 28 through col. 5, line 15) (claim 26);

The winning bids in the auctions are determined manually by an auction initiator at any time during the auction (Silverman, col. 7, line 35 through col. 8, line 65) (claim 27);

If a winning bid for each seller's auction is identified the electronic exchange network automatically sends a tender offer to an initiator of the seller's auction (Silverman, col. 8, lines 1-67) (claim 28);

The electronic exchange network enables each of the sellers to publish one or more preferred customer catalogs that are made accessible by the electronic exchange network only to buyers that are designated preferred catalog customers by the publishing seller (Silverman, col. 10, line 59 through col. 11, line 5) (claim 29);

The published transaction catalogs comprise a description of transportation services quoted as being made available by each seller to the buyers and associated fee rates for those services (Silverman, col. 10, line 59 through col. 11, line 5), and wherein the buyer can identify services and rates for the desired services by matching the quoted transaction services according to a manner selected from the group consisting of:

Manually reviewing the published transaction catalogs for sellers of interest, and manually identifying matching services having acceptable rates for the desired services (Silverman, col. 7, line 35 through col. 8, line 58),

Querying the electronic exchange network so as to cause the network to search among the published transaction catalogs of one or more sellers and automatically identifying matching services, and reviewing the automatically matched queried services and identifying a desired one of the automatically matched queried services (Silverman, col. 7, line 35 through col. 8, line 58), and

Identifying a desired seller and describing the desired services and commanding the electronic exchange network to identify matching services from the published transaction catalog of the desired seller and to automatically select a best one of the matched desired seller services (Silverman, col. 7, line 35 through col. 8, line 58) (claim 30);

The electronic exchange network automatically sends, as appropriate, a purchase order for the matched desired seller services to the desired seller, a purchase order for the desired one of the automatically matched queried services to an appropriate seller, and a purchase order for the manually identified matched service having acceptable rates for the desired services to an appropriate seller (Silverman, col. 7, lines 50-55) (claim 31); and

The electronic exchange network automatically identifies the desired one of the automatically matched queried services (Silverman, col. 7, line 35 through col. 8, line 58) (claim 34).

Previous indications of allowable subject matter are herein withdrawn in view of the newly cited art.

***Response to Arguments***

Applicant's arguments with respect to claims 1-41 (in both previous office actions) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Moffett patent discloses an electronic system that allows the users to customize who uses the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



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VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600